

REMARKS

Status of the claims

Claims 1-7 and 11-18 are currently pending in the present application. The Office Action is non-final. Claims 8-10 have been cancelled. Claims 1-7 and 11-18 remain pending in the present application. Claim 1 has been amended. New claims 19-20 have been added.

Support for amended Claim 1 can be found in the present specification at page 11, lines 26-30. Support for newly added claim 19 can be found in the present specification at page 11, lines 14-17 and 30-33. Support for newly added claim 20 can be found in the present specification at page 8, lines 6-12, and page 9 lines 21-22.

Applicants respectfully request reconsideration of each of the pending claims (i.e., claims 1-7 and 11-18), including amended and new claims based on the following comments.

Issues Under 35 U.S.C. § 103(a)

Claims 1-7 and 11-18 stand rejected under 35 U.S.C. § 103(a) as unpatentable over the Admitted Prior Art (APA) in view of Takuman (EP 1225211) and Simizu (U.S. 4,216,140).

Combination of the Cited References

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success.

Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.

The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). "There are three possible sources for a motivation to combine references: the nature of the problem to be solved, the teachings of the prior art, and the knowledge of persons of ordinary skill in the art." *In re Rouffet*, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457-58 (Fed. Cir. 1998). The level of skill in the art cannot be relied upon to provide the suggestion to combine references. *Al-Site Corp. v. VSI Int'l Inc.*, 174 F.3d 1308, 50 USPQ2d 1161 (Fed. Cir. 1999). "In determining the propriety of the Patent Office case for obviousness in the first instance, it is necessary to ascertain whether or not the reference teachings would appear to be sufficient for one of ordinary skill in the relevant art having the reference before him to make the proposed substitution, combination, or other modification." *In re Linter*, 458 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972). Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. "The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art." *In re Kotzab*, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000). See also *In re Lee*, 277 F.3d 1338, 1342-44, 61 USPQ2d 1430, 1433-34 (Fed. Cir. 2002) (discussing the importance of relying on objective

evidence and making specific factual findings with respect to the motivation to combine references); In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); In re Jones, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

A *prima facie* case of obviousness has not been established for this case, even if the cited references are combined, since none of the cited references provides any teaching, suggestion, or motivation to the present invention. As indicated in the proposed amended Claim 1, calcium carbonate is removed from the inorganic filler. The claim has been narrowed to an inorganic filler consisting of an aluminum hydroxide powder or an aluminum hydroxide powder and at least one reinforcing or non-reinforcing filler selected from the group consisting of silica, titanium dioxide, calcium silicate, ferric oxide and carbon black.

By amending Claim 1 to explicitly limit the inorganic filler to only the selected group, this further narrows the claim to not to include calcium carbonate. Because of this narrowing there is no motivation or teaching from the references to exclude calcium carbonate. Calcium carbonate is an essential feature in the Simizu reference. The Simizu reference fails to disclose or teach the presently claimed invention. Therefore the cited references no longer apply.

Accordingly, Applicants traverse this rejection, and respectfully requests reconsideration of the claims and withdrawal of the cited rejections.

CONCLUSION

In view of the above amendment and comments, Applicants respectfully submit that the claims are in condition for allowance. A notice to such effect is earnestly solicited.

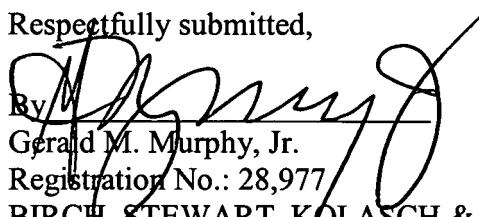
Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Paul D. Pyla, Reg. No. 59,228, at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37.C.F.R. §§1.16 or 1.14; particularly, extension of time fees.

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Respectfully submitted,


By _____
Gerald M. Murphy, Jr.
Registration No.: 28,977
BIRCH STEWART, KOLASCH & BIRCH, LLP
8110 Gatehouse Road
Suite 100 East
P.O. Box 747
Falls Church, Virginia 22040-0747
(703) 205-8000
Attorney for Applicant